

REMARKS

This is a full and timely response to the final Official Action mailed on March 11, 2003 (Paper No. 6). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, claims 8 and 11 have been cancelled. Amendments to claims 10, 16 and 25 are proposed. No new claims are added. Thus, claims 1-4, 9, 10, 12-19 and 25 are currently pending.

In the outstanding Office Action, The Examiner objected to claims 8, 10 and 11. With the cancellation herein of claims 8 and 11, only the objection to claim 10 remains.

Claim 10 was objected to as not being a proper dependent claim. Consequently, Applicant proposes herein to amend claim 10 so as to present it in independent form.

The proposed amendment to claim 10 does not add any new material or recitations to claim 10 and, thus, does not raise any new issues. Additionally, the proposed amendment places claim 10 in better condition for further prosecution. Consequently, entry of the amendment to claim 10 is proper under 37 C.F.R. § 1.116 and is hereby respectfully requested. Following entry of the amendment to claim 10, Applicant submits that the objection to claim 10 will no longer be appropriate and should be withdrawn.

With regard to the prior art, the Examiner rejected claims 1 and 8-11 as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 6,284,339 to Floegel et al. ("Floegel") and U.S. Patent No. U.S. Pat. No. 2,293,887 to Chamberlain ("Chamberlain"). For at least the following reasons, this rejection is respectfully traversed.

Claim 1 recites:

A method of making a user-customized electrostatic sticker, said method comprising:
printing a user-selected image on sticker print medium, said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker; and
depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image, wherein said charge donor is separate from, and not a part of, said sticker print medium.

The outstanding Office Action acknowledges that Floegel does not teach or suggest “depositing an electrostatic charge on said sticker print medium with a charge donor,” where the “charge donor is separate from, and not a part of, the sticker print medium.” (Paper No. 6, p. 6). Consequently, the Office Action proposes to combine the teachings of Floegel with those of Chamberlain. According to the Office Action, “Chamberlain discloses depositing a charge to a print medium during mounting of the medium to a surface, wherein said charge donor is separate from, and not a part of, said sticker print medium.” (*Id.*).

As given in the Office Action, the motivation to combine the teachings of these two references “would have been to increase the strength of attraction or adhesion when mounting the medium.” (*Id.*). However, this would not be the effect of combining the teachings of Floegel and Chamberlain as proposed.

According to Floegel, a charge is developed by heating the print medium in the presence of an electric field to induce an electric dipole moment. (Col. 1, lines 57-63; and col. 3, lines 12-15). When the plastic sheet is cooled, the result is a “permanent electrostatic charge.” (Col. 1, line 58).

Under the most basic principles of electrostatics, this “permanent electrostatic charge” will repel any like charge. Consequently, if a “charge donor” were brought into contact with the electret sheet taught by Floegel, the permanent electrostatic charge on the sheet would repel and prevent the addition of any further like charge from the charge donor.

Thus, it is not true, as the Office Action suggests, that a separate charge donor as taught by Chamberlain could be used to increase the strength of the charge

on the sheet taught by Floegel. The use of a charge donor with the sheet taught by Floegel would not be attempted by one of ordinary skill in the art. Therefore, there is no motivation in the prior art to combine the teachings of Floegel and Chamberlain as suggested in the recent Office Action.

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992)." M.P.E.P. § 2143.01 (emphasis added). Consequently, the rejection of claim 1 based on the improperly combined teachings of Floegel and Chamberlain should be reconsidered and withdrawn. The same applies to the rejections of claims 2-4, 9 and 10, which rejections also rely on the proposed combination of Floegel and Chamberlain.

Claim 25 was rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 4,992,121 to Rubino ("Rubino"). Claims 16-19 were under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 2,293,887 to Chamberlain ("Chamberlain").

These rejections are respectfully traversed as follows.

The present paper proposes an amendment to both claim 16 and claim 25. Claim 16, as amended, would read as follows:

16. (currently amended) An electrostatic sticker kit comprising a kit including:
at least one blank sheet of an electrostatic sticker print medium; and
a charge donor, other than said sticker print medium, for depositing an electrostatic charge on either side of said sticker print medium;
wherein said at least one blank sheet of sticker print medium and said charge donor are ~~associated~~ packaged together in said kit.

Similarly, it is proposed to amend claim 25 to read:

25. (currently amended) A business method comprising providing an electrostatic sticker kit, said providing an electrostatic sticker kit comprising providing a kit containing at least one blank sheet of an electrostatic sticker print medium and a charge donor, other than said sticker print medium, for

depositing an electrostatic charge on either side of said sticker print medium, wherein said at least one blank sheet of an electrostatic sticker print medium and said charge donor are ~~associated~~ packaged together to form said kit.

Entry of these proposed amendments is hereby requested. Applicant will demonstrate that entry of these proposed amendments is proper under 37 C.F.R. § 1.116 for at least the following reasons.

The proposed amendments do not raise new issues. The recent Office Action considered at length the definition of the word "kit." As indicated in the Office Action, the possible definitions of the word "kit" range from a narrow definition (i.e., a set of material packaged together for sale) to the "broadest reasonable" definition (i.e., "a set of article or implements used for a specific purpose"). (Paper No. 6, p. 9).

Applicant proposes the amendments to claims 16 and 25 to clarify the meaning of the word "kit" as used in the specification and claims. Applicant proposes to explicitly adopt that definition of the term "kit" in claims 16 and 25 which includes a set of items "packaged" together. Such claim language is within the established definitions of the term "kit" as recognized by the outstanding Office Action. Consequently, such a definition of the term "kit" is within the scope of Applicant's specification. More importantly, the proposed amendments defining "kit" as a "packaged" set of items were explicitly anticipated and considered in the recent Office Action. (Paper No. 6, p. 6). Thus, the proposed amendments to claims 16 and 25 do not raise a new issue. See, M.P.E.P. § 706.07(a).

Additionally, these proposed amendments place claims 16 and 25 in clear condition for allowance over the prior art of record. The recent Office Action agrees that Rubino and Chamberlain both fail to teach or suggest a "kit" in which the recited items are "packaged" together. (Paper No.6, pp 8-9).

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (citations omitted). Therefore, upon entry of the proposed amendments to claims 16 and 25, the rejection of claims 16-19 and claim 25 based, respectively, on Chamberlain and Rubino, should be reconsidered and withdrawn.

And, for this additional reason, entry of the proposed amendments to claims 16 and 25 is proper under 37 C.F.R. § 1.116 and is hereby requested.

The recent Office Action also rejects claims 12-15 as anticipated under 35 U.S.C. § 102(b) by Longtin ("Longtin"). For at least the following reasons, this rejection is respectfully traversed.

Claim 12 recites:

An electrostatic sticker print medium for use with a printer, said sticker print medium comprising:
a blank sheet of electrostatic print medium;
an electrostatic charge deposited on a side of said sticker print medium; and
a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium.

Applicant wishes to point out that claim 12 recites a "blank sheet of electrostatic print medium" which is to be used "with a printer." As indicated in Applicant's specification, the invention may be embodied in a system that includes "a host computer for generating a user-selected image; a printer connected to the host computer for receiving print data corresponding to the user-selected image; and a sticker print medium on which the user-selected image is printed with the printer to produce the user-customized sticker. The print medium includes an electrostatic charge that allows the medium to be adhered to a surface as an electrostatic sticker. Preferably, the printer is an inkjet printer." (Spec., paragraph 15).

In contrast, Longtin fails to teach or suggest a "blank sheet of electrostatic print medium" that can be used "with a printer" such as an inkjet printer. Rather, Longtin teaches a roll (10), not a sheet, of commercially printed stickers (30). Thus, Longtin fails to teach or suggest the claimed "blank sheet of electrostatic print medium" for use "with a printer" such as an inkjet printer to generate a user-customized sticker, as opposed to a commercially printed sticker.

As noted before, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of*

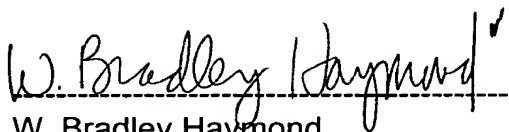
California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, Longtin cannot anticipate claim 12. Thus, the rejection of claim 12 and its dependent claims, based solely on Longtin, should be reconsidered and withdrawn.

Finally, Applicant requests reconsideration of the finality of the recent Office Action. M.P.E.P. § 706.07 states that "[b]efore final rejection is in order a clear issue should be developed between the examiner and the applicant." "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her case."

In the present instance, a clear issue has not been developed and Applicant is still seeking to express the invention in claim language that would give Applicant the patent protection to which Applicant is justly entitled. Therefore, pursuant to M.P.E.P. § 706.07, Applicant hereby requests reconsideration and withdrawal of the finality of the recent Office Action.

For the foregoing reasons, the present application is thought to be in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, reading "W. Bradley Haymond", is written over a horizontal dashed line.

W. Bradley Haymond
Registration No. 35,186
Attorney For Applicant
Tele: (541) 715-0159
Fax: (541) 715-8581